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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,957	01/11/2001	Robert N. Hanson	ZAA-011.01	9648

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EXAMINER

EPPERSON, JON D

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/758,957

Applicant(s)

HANSON ET AL.

Examiner

Jon D Epperson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 15 and 55-60.Claim(s) withdrawn from consideration: 18 and 19.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: Please see attached sheet

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The After-Final amendment is denied entry for the following reasons:

1. Claim 15 (currently amended) inserts new claim limitations (e.g., “-CON(R₄)₂”), which introduces new search and consideration and the issue of new matter.

In order to expedite the future prosecution of the present application the following comments are noted:

2. Applicants argue that they are in possession of the claimed invention because they provide [1] for the “-CON(R₄)₂” R₁ moiety in claim 15, a generic formula (i.e., A,B,C-S) and two examples of compounds that allegedly fall within the sub-generic currently being claimed (e.g., see 7/30/04 Response, pages 4-7, especially page 6 wherein Applicants contend that compounds Z-28 and Z-38 fall within the subgenus of Formula (II) of claim 15) and [2] for the R₂ and R₃ moieties, generic claim language for an “aryl group” which encompasses “... halogen” and various examples of aromatic compounds (e.g., figures 5-7 and 11), which “entitle them to claim any substituted aromatic ring” (e.g., see 7/30/04 Response, page 7).

3. The Examiner contends that this is not sufficient support for the currently claimed subgenus because a broad generic disclosure is not sufficient support for a specific entity or a specific sub-generic within the class (e.g., See, *In re Lukach*, 442 F.2d 967, 169 USPQ 795 (CCPA 1971) (subgenus range was not supported by generic disclosure and specific example within the subgenus range); *In re Smith*, 458 F.2d 1389, 1395, 173 USPQ 679, 683 (CCPA 1972)

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(a subgenus is not necessarily described by a genus encompassing it and a species upon which it reads). Here, Applicants provide [1] even less support for the claimed sub-generic than was held to be impermissible in *In re Lukach* and/or *In re Smith* because Applicants do not even provide species that fall within the sub-genus. For example, compounds Z-28 and Z-31 (cited by Applicants on page 7 of the 7/30/04 Response) do not fall within the currently claimed sub-generic (i.e., formula (II)) because these compounds contain a piperidine ring (i.e., NC₅) instead of the requisite piperazine ring (i.e., N₂C₄) and thus provide NO support for the currently claimed sub-genus. In addition, the Examiner notes that [2] the “aryl” group to which Applicants refer is not recited in the currently claimed sub-generic either and, as a result, Applicants arguments are moot. Furthermore, the compounds to which Applicants refer in figures 5-7 and 11 (e.g., see 7/30/04 Response, page 7) do not fall within the scope of the currently claimed sub-genus and, as a result, again provide NO support. Finally, the Examiner notes that in the absence of any contradictory legal support (which is the case here), *In re Gimme, Keil, and Schmitz* (124 USPQ 499 (CCPA 196)) controls as set forth in the original rejection (along with *In re Lukach* and/or *In re Smith* as set forth above).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

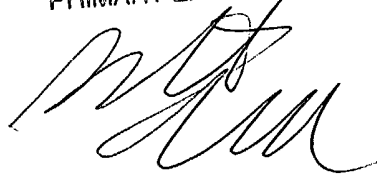
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jon D. Epperson, Ph.D.
August 26, 2004

BENNETT CELSA
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'B. Celsa', written over the printed name and title.